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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/782,793 | 02/13/2001 | Robert J. Allwein | 7147 | 9655 |

7590 09/01/2004

JOHNS MANVILLE INTERNATIONAL, INC.
Legal Department
P.O. Box 5108
Denver, CO 80217

EXAMINER

GLESSNER, BRIAN E

ART UNIT PAPER NUMBER

3635

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,793

Applicant(s)

ALLWEIN ET AL.

Examiner

Brian E. Glessner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 106-145 is/are pending in the application.
- 4a) Of the above claim(s) 120-133 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 106-118 and 134-144 is/are rejected.
- 7) ☒ Claim(s) 119 and 145 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/26/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following office action is in response to the election filed on July 20, 2004. Claims 106-145 are pending in the application. Claims 106-118 and 134-144 are rejected as set forth below, claims 119 and 145 are objected to, and claims 120-133 are withdrawn as being drawn to a non-elected invention.

Election/Restrictions

Applicant's election without traverse of the restriction in the reply filed on July 20, 2004 is acknowledged.

Information Disclosure Statement

The information disclosure statement filed April 26, 2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it does not comply with 37 CFR 1.98(a)(2)(iv)(i) and (ii). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 106, 107, 110, 111, 115, 134, 136, 139, 140 and 143 are rejected under 35 U.S.C. 102(b) as being anticipated by Stokes (1,238,356).

In regard to claims 106 and 134, Stokes discloses a building material comprising fibrous insulation (A) having a length, a width, and a depth, wherein the length and the width define first and second major surfaces separated by the depth, the fibrous insulation having at least one cut (a) extending from the first major surface, through the depth, to the second major surface, said cut extending along at least a portion of the length of the fibrous insulation so as to divide the fibrous insulation into a plurality of fibrous insulation strips, wherein the fibrous insulation strips are removably secured by a means (a') across the at least one cut such that the fibrous insulation may be separated by hand into strips for installation into a cavity. Although Stokes does not specifically refer to his material as insulation, the examiner would like to point out that his material is made of a fibrous material. Therefore, it is capable of being used as an insulating material. Thus, it meets the claimed limitations.

In regard to claims 107, 110, 111, 136, 139 and 140, Stokes discloses the claimed invention, wherein at least one of the fibrous insulation strips has a width of about four, four and one half, or five inches, i.e. five inches, lines 25-27. The examiner would like to point out that 4 and 4 ½ inches are "about" 5 inches.

In regard to claims 115 and 143, Stokes discloses the claimed invention, wherein the building material has three cuts that divide the fibrous insulation into four strips. Although Stokes shows the use of four cuts, he still meets the limitations of the claims

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because the applicant does not claim that the material has only three cuts. Therefore, as long as Stokes has at least three cuts, he meets the claimed limitations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 108, 109, 112, 113, 116-118, 137, 138, 141, 142 and 144 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stokes (1,238,356).

In regard to claims 108, 109, 112, 113, 137, 138, 141 and 142, Stokes discloses the claimed invention except for specifically disclosing that the width of the strips are about 3 or 2 ½ inches, or that the width is about 14 or 23 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make Stokes' material and strips with the above dimensions, since it has been held that where the general conditions of claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Further, one having ordinary skill in the art would be capable of making the strips with the most commonly used widths.

In regard to claims 116, 117, 118, and 144, Stokes discloses the claimed invention except for specifically disclosing that at least two of the strips have a different width, wherein one of the strips is about 2.5 or 11.5 inches, one of the strips is about 4 inches, and one of the strips is about 4.5 or 3.5 inches. It would have been obvious to

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one having ordinary skill in the art at the time the invention was made to make the strips of different widths, because not all of the strips will be used for the application.

Therefore, one may need a strip of one width for one application and a strip of a second or third width for a different application. Thus, by providing the strips with different widths, the different applications would be covered without having to hand cut the pre-cut strips to a new width.

Claims 106-113, 115-118, 134 and 136-144 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michelsen (5,765,318) in view of Stokes (1,238,356).

In regard to claims 106 and 134, Michelsen discloses a building material comprising fibrous insulation (20) having a length, a width, and a depth, wherein the length and the width define first and second major surfaces separated by the depth, the fibrous insulation having at least one cut (figure 7B) extending from the first major surface, through the depth, to the second major surface, said cut extending along at least a portion of the width of the fibrous insulation so as to divide the fibrous insulation into a plurality of fibrous insulation strips, wherein the fibrous insulation strips are removably secured by a means (34) across the at least one cut such that the fibrous insulation may be separated by hand into strips for installation into a cavity. Michelsen does not specifically disclose that the cuts are disposed along the length of the insulation assembly. However, Michelsen does disclose that some wall and ceiling cavities are not of the same length due to window and door openings, column 1, lines 42-49. Therefore, along the same lines, the examiner would also like to point out that one having ordinary skill in the art knows that the width of said wall cavities is also

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sometimes reduced by the inclusion of door and window openings. Stokes teaches that it is known to divide a roll of fibrous material in a lengthwise manner. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to divide Michelsen's insulation material along the length, because as stated above, those having ordinary skill in the building art know that the width of wall cavities is sometimes reduced by the inclusion of door and window openings. Therefore, the need for odd sized widths of insulation are also needed to fill odd sized cavities in walls formed near the ends of walls or around door and window openings.

In regard to claims 107, 110, 111, 136, 139 and 140, Michelsen in view of Stokes disclose the basic claimed invention, wherein Stokes further teaches that at least one of the fibrous insulation strips has a width of about four, four and one half, or five inches, i.e. five inches, lines 25-27 (Stokes). The examiner would like to point out that 4 and 4 ½ inches are "about" 5 inches.

In regard to claims 115 and 143, Michelsen in view of Stokes disclose the basic claimed invention, wherein Stokes further teaches that the building material has three cuts that divide the fibrous insulation into four strips. Although Stokes shows the use of four cuts, he still meets the limitations of the claims because the applicant does not claim that the material has only three cuts. Therefore, as long as Stokes has at least three cuts, he meets the claimed limitations.

In regard to claims 108, 109, 112, 113, 137, 138, 141 and 142, Michelsen in view of Stokes disclose the basic claimed invention, wherein the width of the insulation is about 14 or 23 inches, column 1, lines 23-35. Michelsen in view of Stokes do not

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specifically disclose that the width of the strips is about 3 or 2 ½ inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make Michelsen in view of Stokes' material and strips with the above dimensions, since it has been held that where the general conditions of claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Further, one having ordinary skill in the art would be capable of making the strips with the most commonly used widths.

In regard to claims 116, 117, 118, and 144, Michelsen in view of Stokes disclose the basic claimed invention except for specifically disclosing that at least two of the strips have a different width, wherein one of the strips is about 2.5 or 11.5 inches, one of the strips is about 4 inches, and one of the strips is about 4.5 or 3.5 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the strips of different widths, because not all of the strips will be used in the same cavity. Therefore, one may need a strip of one width for one cavity and a strip of a second or third width for a different cavity. Thus, by providing the strips with different widths, the different applications would be covered without having to hand cut the pre-cut strips to a new width.

Claims 114 and 135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michelsen (5,765,318) in view of Stokes (1,238,356) and further in view of Schelhorn et al. (5,277,955).

In regard to claims 114 and 135, Michelsen in view of Stokes disclose the basic claimed invention, wherein the building material further comprises a vapor barrier facing

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sheet 54 covering the first major surface, wherein the facing sheet comprises at least one separable connector 30 aligned with the at least one cut. Michelsen in view of Stokes do not specifically disclose that the facing sheet is bonded to the first major surface. Schelhorn teaches that it is known to bond a facing sheet to an insulation material with an adhesive 22. It would have been obvious to one having ordinary skill in the art at the time the invention was made to adhere Michelsen's facing sheet to his insulation material, because the adhesive will prevent the insulation material from sliding out of the cavity formed by the facing sheets. If the insulation assembly is open at both sides and not adhered to the facing sheet as shown in figure 3, the insulation material would slide right out from between the facing sheets. This would not be desired. Thus, one having ordinary skill in the art would know that the use of adhesive would prevent this from happening.

Allowable Subject Matter

Claims 119 and 145 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fathi, Bondra, Jr. et al., and Ray, Jr.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Glessner whose telephone number is 703-305-0031. The examiner can normally be reached on Monday through Friday 7:00-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian E. Glessner
Primary Examiner
Art Unit 3635

B.G.
August 30, 2004